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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,696	08/31/1999	GEORGE GOICOECHEA	BSI-212	2901

7590

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PAUL F PRESTIA  
RATNER & PRESTIA  
SUITE301 ONE WESTLAKES BERWYN  
P O BOX 980  
VALLEY FORGE, PA 194820980

EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 09/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/387,696

Applicant(s)

GOICOECHEA ET AL.

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on June 13, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 54-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 61 recites "segments having apices in a plane substantially perpendicular to the longitudinal axis of the stent" (see lines 5-6). According to the specification (see Figure 2A), the segments have apices 22 in a plane substantially parallel to the longitudinal axis of the stent.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 54, 57, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by MacGregor (US 4,994,071). MacGregor discloses a tubular prosthesis having a tubular surface being axially subdivided into two or more hoop-like tubular portions formed from corrugated portions of two or more wires or filaments and connected by straightened extension portions (see Abstract; column 2, lines 23-36; column 4, lines 1-10; Figures 1 and 1A). It should be noted that Figure 1A clearly shows "at least two of said hoop-like tubular portions are axially arranged **generally adjacent to one another**".

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5. Claims 54, 55, 56, 57, 59, 60, and 61 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Song (WO 92/06734 A1). As seen in Figures 1-3 and 6, Song discloses a tubular prosthesis being axially divided into two or more hoop-like tubular portions (unit structures 11, 12, 13, and 14, or, unit structures 21, 22, 23, and 24) formed from corrugated portions of two or more wires or filaments (each unit structure is described as a wire “formed into a closed zig zag configuration thereby forming a series of straight sections 111 and bends 112”; see Figure 1; see page 5, lines 17-23) and connected by straightened extension portions (connecting members 31, 33, 35, and 37; see Figures 2 and 3; see page 6, lines 2-7) that could be placed diagonally (skew or in a helical path) along the longitudinal axis of the tubular prosthesis (see Figures 2 and 3; see page 6, lines 7-12).

### ***Response to Arguments***

6. Regarding 102(b) rejection over MacGregor, Applicant's arguments filed June 13, 2003 have been fully considered but they are not persuasive.

a. Regarding claims 54 and 57, Applicants argue that “Figure 1A of MacGregor shows loops 12 that are separated by at least a loop's axial width. In other words, the gap interposed to separate successive loops 12 is larger than the axial width of the loops themselves. Such a configuration cannot be considered to constitute “hoop-like tubular portions...axially arranged generally adjacent to one another” as recited in Applicants' claim 54”. Examiner respectfully disagrees.

The language of claim 54 and 57 requires that at least two of the hoop-like tubular portions be axially arranged generally adjacent to one another. For such small devices, “generally adjacent” fit the definition of generally lying near or close at hand.

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7. Applicant's arguments with respect to claims 55, 56, 59, 60, and 61 have been considered but are moot in view of the new ground(s) of rejection.

### Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:00-4:30), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Javier G. Blanco  
September 6, 2003



David H. Willse  
Primary Examiner